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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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SNELL & WILMER ONE ARIZONA CENTER 400 EAST VAN BUREN PHOENIX, AZ 850040001			WALSH, DANIEL I	
			ART UNIT	PAPER NUMBER
			2876	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/710,326

Applicant(s)

BONALLE ET AL.

Examiner

Daniel I. Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7-04, 8-04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Receipt is acknowledged of the IDS received on 1 July 2004 and 5 August 2004.

Claim Objections

2. Claims 1 and 16 are objected to because of the following informalities:

Re claim 1: Replace "a reader configured" with -- said reader configured --.

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-47 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-47 of copending Application No. 10/708,833. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '833 Patent Application recites a transponder reader system, while the current Patent Application recites a smartcard system. However, the Examiner notes that smart cards and transponders can be used interchangeably, and are obvious expedients based on design or system constraints. The interchangeability/obviousness of such devices is known in the art, and taught by Black (see below), which uses smartcards and transponders interchangeably.

i) For example, in claim 1 of the current Patent Application the Applicants claim: "A smartcard transaction system...smellprint sensor...facilitate a transaction." (see claim 1), whereas in the '833 Patent Application the Applicants claim: "A transponder-reader transaction system....smellprint sensor...facilitate a payment transaction." (see claim 1)

ii) For example, in claim 23 of the current Patent Application the Applicants claim: "A method for facilitating...smartcard...smellprint...authorization of a transaction." (see claim 23), whereas in the '833 Patent Application the Applicants claim: "A method for facilitating...transponder-reader...smellprint...authorization of a payment transaction." (see claim 23).

iii) For Example, in claim 35 of the current Patent Application the Applicants claim: "A method for facilitating...smartcard...smellprint...proffered smellprint sample." (see claim 35), whereas in the '833 Patent Application the Applicants claim: "A method for facilitating...transponder-reader...smellprint...proffered smellprint sample." (see claim 35).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-16, 18, and 20-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black (US 6,925,565), in view of Justin (US 2005/0211784).

Re claim 1, Black teaches a smartcard configured to communicate with a reader, a reader configured to communicate with the system, a biometric sensor to detect a sample, the sensor configured to communicate with the system (FIG. 1A). Though silent to a verification device to

verify the sample, the Examiner notes that a transaction is authorized upon verification of the sample. Therefore, at the time the invention was made, it would have been obvious to have a verification device in order to verify the sample as part of the authentication (security).

Black is silent to the biometric/scan sample being a smellprint scan sample.

The Examiner notes that biometric samples are well known and conventional in the art, and include DNA, fingerprints, smellprints/odors, retina scans, etc., as means to authenticate an individual. It would have been an obvious expedient to use a smellprint as an alternative means to identify a person, with enhanced security. The Examiner notes that there are alternative types of biometrics that can be used to identify an individual. The selection of which biometric is within the skill in the art, based on the system constraints, costs, etc. Nonetheless, Justin teaches that various biometric sensors are well known and conventional for identification, and can include odor detection (interpreted as a smellprint) (paragraph [0025]). Additionally, the Examiner notes that cards having sensors or separate devices with sensors working with cards are well known and conventional in the art.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Justin.

One would have been motivated to do this in order to have different forms of biometric identification, well know and conventional in the art, to verify a user securely.

Re claim 2, the Examiner notes that the sensor communicates with the system via at least one of a smartcard, reader, and network (FIG. 1A of Black).

Re claim 3, it is understood that the biometric sensor is configured to facilitate a finite number of scans (one for example) in order to receive a sample (namely one).

Re claim 4, FIG. 5A+ (of Black) shows that the fingerprint biometric sensor logs/stores at least one of a detected fingerprint sample, processed sample, and stored sample. Accordingly, it would have been obvious to log the odor/smellprint sample for such record keeping purposes.

Re claims 5-6, Black teaches (col 6, lines 56+) that the customer record can be stored locally or remotely. The Examiner notes that though Black is silent to a datapacket stored on a database, Black teaches that the customer record can include biometric information, user information, etc. (FIG. 5A+ for example). Therefore, the Examiner notes that it would be within the skill in the art for such a collection of data can be interpreted as a data packet (and to include the smellprint/odor data as discussed above). It would have been obvious to store such information on a database, in order to have a well-known and conventional means of storing data for quick retrieval and organization. It has been discussed above that the data can be stored remotely or locally. Accordingly, it would have been obvious to one of ordinary skill in the art to store it on the smartcard or a remote device based on security needs.

Re claim 7, it has been discussed above that samples are received and stored for providing security/authentication. It would have been obvious for the samples to be received by an authorized receiver in order to ensure security and reliability.

Re claim 8, though Justin teaches an odor sensor, Justin is silent to it having at least an electronic, chemical, gas chromatograph, spectrometer, conductivity, or piezoelectric sensor. The Examiner notes that such a sensor is well known and conventional for odor/smellprints and therefore is an obvious expedient to detect and process a proffered smellprint/odor sample.

Re claim 9, it is well known and conventional in the art for odors/smellprints to be verified against at least one of statistical, ANN, and neuromorphic techniques, which are well

known and conventional for odor/smellprint detection and processing, and therefore is an obvious expedient for such purposes.

Re claim 10, the Examiner notes that Justin teaches an odor/smellprint sensor. Accordingly, it is obvious to one of ordinary skill in the art that such a sensor would be configured to detect and verify such claimed characteristics as part of its processing.

Re claim 11, the Examiner notes that Black/Simon are silent to detecting and verifying false odorants, man made smells, abnormal odorants and body heat. However, the Examiner notes that if the smellprint/odor sample provided to the sensor does not match a stored sample or is not an adequate sample, an error or mismatch would result. Accordingly, such a function can be interpreted as detecting/verifying false/abnormal odorants (odors/smells that do not match).

Re claim 12, the Examiner notes that such security procedures are well known and conventional in the art for ensuring the authenticity of samples (Applicants own specification). As discussed above by the abstract of Black, a proffered sample is compared to a stored sample (a record) to verify the user.

Re claim 13, it has been discussed above that a comparison is performed. The Examiner notes that it would have been obvious to one of ordinary skill in the art to use a local CPU/third party security vendor device to electronically perform the comparison, in order to have an electronic (automated) means to quickly and reliably perform the comparison, as is conventional in the art. Black teaches (above) that the comparison is performed electronically. As such, the use of such a local CPU/third party security vendor to perform the comparison is an obvious expedient to accurately/electronically perform the comparison process.

Re claim 14, the Examiner notes that as a sample is stored, it's interpreted as registered.

Re claim 15, Black teaches that a customer's account is linked to the sample data, and can be used for payment and is linked to a credit or debit account (abstract, col 6, lines 46+).

Re claim 16, the Examiner notes that it is obvious that the system of Black would be used by a plurality of customers. As such, it would have been obvious that different people have different samples (unique), which would be associated with their different accounts.

Re claim 18, as Black teaches an account is only accessed after a sample is verified, it is interpreted as beginning authentication after verification of the sample.

Re claim 20, though Black is silent to the sensor providing notification upon detection of a sample, the Examiner notes that it is well within the skill in the art to provide notification that a sample has been detected, in order to provide indication to the user, that the sample was received and they don't have to keep offering a sample (suitable indications that electronic operations have been completed include audible information, textual information, etc., as is conventional in electronic transactions). As Black indicates when a sample has been authorized (transaction allowed) it would have been obvious to indicate when the sample is read/detected as a means to provide guiding information to the user. Additionally, the Examiner notes that the mere authorization of a transaction can be broadly interpreted as providing notification upon detection of a sample because authorization cannot occur unless the sample was detected.

Re claim 21, it has been discussed above that the device facilitates a financial transaction.

Re claims 22 and 34, though silent to secondary security procedures, the Examiner notes that such procedures such as PINs, codes, passwords, additional identifiers etc. are well known and conventional in the art. One would have been motivated to use such procedures for increased security.

Re claim 23, Black/Justin teach a method for facilitating biometric security in a smartcard/reader system comprising providing a smellprint/odor to a sensor communicating with the system to initiate verification of a biometric for facilitating authorization of a transaction, as discussed above.

Re claim 24, the Examiner has interpreted the storing of the sample with the system as an authorized sample receiver.

Re claim 25, registering includes proffering a sample (abstract, FIG. 5A of Black).

Re claim 26, the limitations have been discussed above re claim 8.

Re claim 27, Black teaches that a sample is stored and that proffered samples are compared and verified to complete a transaction (abstract).

Re claim 28, Black teaches the step of proffering a biometric to a sensor communicating with the system to initiate verification, as discussed above. As discussed above, Black teaches that the information can be stored on the smartcard itself or remotely, depending on the desired security. Though silent to a database, a database is an obvious expedient as discussed above. Accordingly, it would have been obvious to process database information contained in at least one of the smartcard, reader, sensor, server, and reader system as a means to authenticate/verify a user. The storage location of verification information can be varied based on security needs, as discussed above.

Re claim 29, Black teaches comparing the proffered sample with stored sample (abstract).

Re claims 30, the limitations have been discussed above, re claim 13.

Re claim 31, the limitations have been discussed above re claim 9.

Re claim 32, the limitations have been discussed above re claim 11.

Re claim 33, the Examiner notes that as the system is used with more than one user (therefore more than one sample) it would have been obvious to detect/process/store a second sample (of additional users).

Re claim 35, Black/Simon teaches a method of facilitating biometric security in a smartcard reader transaction system comprising detecting a proffered smellprint/odor at a sensor communicating with the system to obtain a proffered sample, verifying the sample, and authorizing a transaction to proceed upon verification of the sample (as discussed above.)

Re claim 36, Black teaches that the sample is detected at a sensor configured to communicate with the system via one of a smartcard/reader/network (FIG. 1A-1C).

Re claim 37, the limitations have been discussed above re claim 8.

Re claim 38, the limitations have been discussed above.

Re claim 38, receiving a finite number of scans has been discussed above (namely one sample).

Re claim 40, the storing/logging of samples is an obvious expedient for record keeping purposes, and has been discussed above. Additionally, the Examiner notes that samples are stored/logged at least temporarily (in a buffer) in typical comparison processes (electronically).

Re claim 41, as discussed above, it would have been obvious to one of ordinary skill in the art to detect/process/store a second sample, when the system is used by different people with different accounts and samples.

Re claim 42, the limitations have been discussed above re claim 11.

Re claim 43, the comparison of a proffered sample to a stored/registered sample has been discussed above.

Re claim 44, the limitations have been discussed above re claim 9.

Re claim 45, the Examiner notes that the proffered biometric is indeed compared with a sample of at least one of a criminal, terrorist, and card member, as the sample is compared to a current card members sample, to authorize the transaction.

Re claim 46, verifying the sample using information contained on one of a local database/remote database/third party controlled database would have been an obvious expedient in instances where the data is stored remote from the smartcard (as discussed above, based on security concerns). The biometric would be verified by using information contained in a database, as a preferred means to organize data for efficient and easy storage and retrieval (remote or local).

Re claim 47, the verification of a sample using a protocol/sequence controller (interpreted as a processor) has been discussed above.

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Justin in view of Moebs et al (US 2005/0065872).

The teachings of Black/Justin have been discussed above.

Black/Justin. are silent to primary and secondary associating.

The Examiner notes that such associating is well known in the art (line of credit, for example). Specifically, Moebs et al. teaches that a customer can avoid overdraft by preauthorizing the financial institution to tie the customers' checking account to one or more of the customers other accounts (paragraph [0017]), interpreted as primary and secondary associating.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Justin with those of Moebs et al.

One would have been motivated to do this in order to provide for overdraft protection, for example.

6. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Justin, as discussed above, in view of Goodman (US 2002/0043566).

The teachings of Black/Justin have been discussed above.

Black teaches that the transaction is blocked when the biometrics do not match, as is conventional in the art, but Black is silent to deactivation upon rejection of the sample.

The Examiner notes that it is well known and conventional in the art for card to be disabled, as a security measure, if a predetermined amount of failed attempts are detected, for example. Specifically, Goodman et al. teaches deactivation of a card if a predetermined amount of incorrect PIN attempts are detected (paragraph [0029]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Justin with those of Goodman et al.

One would have been motivated to do this in order to increase system security.

Though Goodman et al. is silent to a biometric input, the Examiner notes that Goodman et al. is relied upon for teaching disabling of access when a matching input is not received. It would have been obvious to disable the smartcard when biometrics don't match (biometrics replacing PIN input, as a more secure alternative).

7. Claims 4, 22, 34, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Justin, as discussed above, in view of Black (US 2005/0122209).

The teachings of Black/Justin have been discussed above.

Re claims 22 and 34, Black/Justin is silent to secondary security procedures. Re claims 4 and 40, Black is silent to logging each sample.

Black '209 teaches such procedures through signature verification (abstract). Black '209 teaches storing of digital and electronic signature for record keeping purposes (paragraph [0125]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Justin with those of Black '209.

One would have been motivated to do this for increased security and record keeping purposes.

Additional Remarks

8. As an example, Janiak et al. (US 2002/0097142) teaches user indication. User indication is well known in the art to keep the user informed during a process. Typical user indication is readily seen at checkouts/point of sale devices, for example.

Simon (US 2005/0212657) teaches that DNA sampling to verify a user (paragraph [0013] and paragraph [0018]), where the sensor can be on the card, a separate unit, etc., and secondary sensors.

McCall et al. (US 2003/0132297) stores/logs signatures.

Haala et al. (US 2005/0102524) teaches recording details if authentication fails.

Segal et al. (US 2002/0066784) teaches bundling a signature with transaction database to effect proof of a transaction.

Hoshino et al. (US 6,636,620) teaches a biometric system.

Kita (US 6,703,918) teaches a transponder biometric system (FIG. 15+).

Rowe (US 2004/0050930) teaches a DNA smartcard with onboard authentication.

Tanaka et al. (US 2005/0160790) teaches breath odor measurements.

9. Additionally, the Examiner notes that it is unclear as to whether the claims (16, 17, 33, and 41) are based upon different samples of different people or of one user. Appropriate clarification is requested.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Haala (US 2005/0102524), Janiak et al. (US 2002/0097142), and McCall et al. (US 2003/0132297), Rowe (US 2004/0050930), Kita (US 6,703,918), and Hoshino et al. (US 6,636,620).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'D. Walsh', with a large, stylized flourish extending from the end.

Daniel I Walsh
Examiner
Art Unit 2876
3-8-06